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EXAMINER

CANTELMO, GREGG

ART UNIT PAPER NUMBER

1745

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,183

Applicant(s)

WANI ET AL.

Examiner

Gregg Cantelmo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the amendment received February 2, 2006:
 - a. Claims 1-9 and 12-27 are pending;
 - b. The drawing objection is withdrawn in light of the amendment to claim 1;
 - c. The 112 1st paragraph rejection of claims 1-7 is withdrawn in light of the amendment to claim 1;
 - d. The 112 1st paragraph rejection of claims 22 and 23 stand;
 - e. The prior art rejections of record stand.

Claim Objections

2. Claim 25 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 22. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 22 and claim 25 define the same projection train limitations and are both directly dependent upon claim 1. Therefore claim 25 is held to be a duplicate of claim 22 and is objected to.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention..

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3. Claims 22 and 25 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no apparent support for the arrangement of claim 22. If the Examiner is in err, Applicant is invited to show where the support for claim 22 is found within the original written description. This also applies to new claim 25.

4. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for having a stopper along a plurality of trains, does not reasonably provide enablement for having a stopper between first and second trains wherein there are no trains between the first and second trains. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In the event that the arrangement of claim 22 is supported by the original disclosure, claim 1 would encompass both a plurality of trains between the 1st and 2nd trains on the body and no trains between them. In the case of the latter embodiment, it would not be understood how the cover train could mate with the 2nd train located at the bottom of the body since the stopper would prohibit this connection.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites that there is no projection train between the first projection train and second projection train. Claims 26 and 27, dependent upon claim 25 each recite that either the first or second projection train comprises a plurality of projection trains. The claimed subject matter is ambiguous as to the exact train configuration of the claimed invention. If either of the first or second projection trains includes a plurality of projection trains then for any given projection train in the plurality there would be intervening projection trains from the plurality between either the first or second train (each of the latter being one projection train). Furthermore claim 25 recites singular projection train for each of the first and second trains. Claims 26 and 27 now reciting plural trains is outside the scope of the train configuration of claim 25 since these claims recite plural trains for a give singular train of claim 25. This combination renders the particular train configuration indefinite.

Response to Arguments

6. Applicant's arguments filed February 2, 2006 have been fully considered but they are not persuasive.

With respect to claim 22: Applicant argues that support for the claimed subject matter can be found in Fig. 1. However the Examiner is not persuaded.

First, Fig. 1 clearly shows 4 projection trains and thus is a teaching away from the arrangement of claim 22. Second, the related disclosure to Fig. 1 teaches that the

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region 18 in Fig. 1 in fact includes a plurality of trains (see page 7, lines 1-5). So while Fig. 1 only shows 4 explicit projection trains, the disclosure related to Fig. 1 on page 7 clearly teaches that a plurality of projection trains are provided substantially over the whole length of the body. Since the disclosure relied upon fails to support the claimed subject matter, the subject matter of claim 22 is still held to introduce new matter and therefore the 112 1st paragraph rejection stands.

With respect to claim 23: Applicant fails to address this rejection and absent any rebuttal, the rejection stands.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3, 5-7 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of U.S. Patent No. 5,819,917 (Nicholson) and U.S. Design Patent No. D 433,562 (Redlinger), all of record.

WO '008 discloses a case including a main body 2 having a first opening portion at one end and a bottom surface 7 at the other end, and a lid portion 1 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 11 run along the length of the main body to the bottom of the body (first and second trains) a third projection train 6 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 1).

Since the structure of the case of WO '008 has a telescoping arrangement wherein the cover can be held at various positions along the length of the body 2 dependent upon which projection train the cover meshes with, the prior art is clearly capable of storing multiple components within the casing. And again the limitations of claim do not positively require the batteries be present in the case nor specify the dimensional relationship between the size of the batteries relative to the size of the case. The shape and dimension of the casing of WO '008 is a telescoping case which can store more than one device within the telescoping container. Again the claims do

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not require that batteries are clearly present but only a configuration of the casing relative to battery devices which could be stored in it.

The body and lid have a circular cross section (Fig. 1 and abstract) which is inherently made up of plural circular arc segments (as applied to claims 2 and 3).

Projection portion of trains 11 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 6).

With respect to claims 25-27, pending clarification as to the 112 2nd rejection of claims 25-27, the structure of the claimed subject matter may read on a plurality of trains as suggested by the structure defined in new claims 26 and 27. WO '008 teaches of a plurality of trains in which any number of grouping of trains can be incorporated into a given grouping of claims such that one group is a plurality of trains and the other group is a singular terminal train (as applied to claims 25-27).

The differences between claims 1, 5 and 7 and WO '008 are that WO '008 does not teach of providing a through-hole in the head portion of the lid (claim 1), of the bottom surface expanded toward the outside via a circumferential ring (claim 5), wherein the through hole has a concave portion and a cylindrical portion (claim 7).

With respect to the lid having a through hole (claims 1, 5 and 7):

Nicholson discloses that an attachment means provided to at least one of the cover or body of the casing 10 permits attachment of the casing 10 to other devices (see Fig. 1).

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 5 and 7 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by configuring the lid to have the through hole since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

Response to Arguments

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10. Applicant's arguments with respect to claims 1-3 and 5-7 have been considered but are not persuasive.

It is held that further amending claims 1-3 and 5-7 to include the particular object stored in the container is not a novel contribution and therefore not patentably distinct over the prior art rejection above.

It is apparent that claim 1 has been amendment such that the claims still do not require the casing to store a battery but only that the casing is capable of fitting a single battery or two batteries relative to the configuration of the telescoping housing. The prior art container of WO '008 is held to be sufficiently capable of storing one or two batteries in the casing depending on the relationship between the body and cover of WO '008. Furthermore there are numerous types of batteries known in the art such as coin shaped batteries for use in devices such as wristwatches.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Furthermore Applicant's response is a piecemeal analysis of the prior art rejection and fails to reason why the combination as set forth above, does not teach the claimed invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

11. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of U.S. Patent No. 5,819,917 (Nicholson) and U.S. Design Patent No. D 433,562 (Redlinger) as applied to claim 1 above and in further view of U.S. patent No. 5,829,591 (Lyons).

The difference not discussed is providing a stopper between the 1st and 2nd projection trains.

The concept of providing a stopper to the body of the casing is known in the art for the purposes of preventing the cover from covering the entire body. If the cover were able to cover the entire body, it would render it difficult to remove the body from the covering. Therefore a stopper means somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) would have provided such an arrangement (See Fig. 1 of Lyons).

While Lyons does not teach of providing the stopper between the 1st and 2nd projection trains, the placement of such is held to be a matter of design choice and that one of ordinary skill in the art would have found it obvious to place the stopper at somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) to prevent the body from being completely inserted into the cover.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the body of WP '008 to include a stopper as somewhere near or at the bottom of the body (the body end furthest from the cover

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receiving end of the body) suggested by Lyons since it would have prevented the body from being completely inserted into the cover. Furthermore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the body to have the stopper disposed near the end of the body and between the first and last trains on the body since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

Claim Rejections - 35 USC § 103

12. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of U.S. Patent No. 5,819,917 (Nicholson) and U.S. Design Patent No. D 433,562 (Redlinger), all of record.

Rosler discloses a case including a main body 1 having a first opening portion at one end and a bottom surface 1' at the other end, and a lid portion 2 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 3 run along the length of the main body to the bottom of the body (first and second trains) a third projection train 4 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 1).

Since the structure of the case of Rosler has a telescoping arrangement wherein the cover can be held at various positions along the length of the body 2 dependent upon which projection train the cover meshes with, the prior art is clearly capable of storing multiple components within the casing. And again the limitations of claim do not positively require the batteries be present in the case nor specify the dimensional relationship between the size of the batteries relative to the size of the case.

The body and lid have a circular cross section (Fig. 2) which is inherently made up of plural circular arc segments (as applied to claims 2 and 3).

The bottom surface 1' is expanded toward the outside via a circumferential ring (Figs. 1 and 2 as applied to claim 4).

Projection portion of trains 3 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 6).

The differences between claims 1, 5 and 7 and Rosler are that Rosler does not teach of providing a through-hole in the head portion of the lid (claim 1), of the head portion having a space portion between the hole and body (claim 4), wherein the through hole has a concave portion and a cylindrical portion (claim 7).

With respect to storing batteries in the container (claim 1):

Rosler is broadly drawn to a container which can be used as a container for any number of items.

With respect to the lid having a through hole (claims 1, 5 and 7):

Nicholson discloses that an attachment means provided to at least one of the cover or body of the casing 10 permits attachment of the casing 10 to other devices (see Fig. 1).

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Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 5 and 7 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by configuring the lid to have the through hole since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

Response to Arguments

13. Applicant's arguments with respect to claims 1-3 and 5-7 have been considered but are moot in view of the new ground(s) of rejection.

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It is held that further amending claims 1-3 and 5-7 to include the particular object stored in the container is not a novel contribution and therefore not patentably distinct over the prior art rejection above.

It is apparent that claim 1 has been amendment such that the claims still do not require the casing to store a battery but only that the casing is capable of fitting a single battery or two batteries relative to the configuration of the telescoping housing. The prior art container of Rosler is held to be sufficiently capable of storing one or two batteries in the casing depending on the relationship between the body and cover of Rosler. Furthermore there are numerous types of batteries known in the art such as coin shaped batteries for use in devices such as wristwatches.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Furthermore Applicant's response is a piecemeal analysis of the prior art rejection and fails to reason why the combination as set forth above, does not teach the claimed invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

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14. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of U.S. Patent No. 5,819,917 (Nicholson) and U.S. Design Patent No. D 433,562 (Redlinger) as applied to claim 1 above and in further view of 5,829,591 (Lyons).

The difference not discussed is providing a stopper between the 1st and 2nd projection trains.

The concept of providing a stopper to the body of the casing is known in the art for the purposes of preventing the cover from covering the entire body. If the cover were able to cover the entire body, it would render it difficult to remove the body from the covering. Therefore a stopper means somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) would have provided such an arrangement (See Fig. 1 of Lyons).

While Lyons does not teach of providing the stopper between the 1st and 2nd projection trains, the placement of such is held to be a matter of design choice and that one of ordinary skill in the art would have found it obvious to place the stopper at somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) to prevent the body from being completely inserted into the cover.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the body of Rosler to include a stopper as somewhere near or at the bottom of the body (the body end furthest from the cover receiving end of the body) suggested by Lyons since it would have prevented the body from being completely inserted into the cover. Furthermore it would have been obvious

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to one of ordinary skill in the art at the time the claimed invention was made to modify the body to have the stopper disposed near the end of the body and between the first and last trains on the body since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

15. Claims 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of Nicholson.

The case comprises a first projection train 3 on the body 1 near the bottom surface of the body and a second projection train 4 formed on the lid 2 near the open end of the lid, wherein the second projection train is adapted to engage the first projection train (Fig. 1 as applied to claim 16).

The body and lid have a circular cross section (Fig. 2) which is inherently made up of plural circular arc segments (as applied to claims 18 and 19).

Plural projection trains are formed on the main body along the span of the body and thus there is a multiple projection trains formed on the main body near the bottom surface and the second projection train (on the lid) is adapted to engage the projection trains (first or third trains) on the main body (Fig. 1 as applied to claim 20).

The difference between claim 16 and Rosler is that Rosler does not teach of the main body storing a battery.

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of Rosler and one of ordinary skill in the art would have found it obvious to

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configure the size of the container of Rosler to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

Response to Arguments

16. Applicant's response provides no amendment to claim 16 nor provides any arguments with respect to claim 16 and 19-20. Therefore there is insufficient reasoning or evidence for withdrawing this rejection and the rejection stands.

Claim Rejections - 35 USC § 103

17. Claims 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson.

The case comprises a first projection train 11 on the body 2 near the bottom surface of the body and a second projection train 6 formed on the lid 1 near the open end of the lid, wherein the second projection train is adapted to engage the first projection train (Fig. 1 as applied to claim 16).

The body and lid have a circular cross section (Fig. 1 and abstract) which is inherently made up of plural circular arc segments (as applied to claims 18 and 19).

Plural projection trains are formed on the main body along the span of the body and thus there is a multiple projection trains formed on the main body near the bottom surface and the second projection train (on the lid) is adapted to engage the projection trains (first or third trains) on the main body (Fig. 1 as applied to claim 20).

The difference between claim 16 and WO '008 is that WO '008 does not teach of the main body storing a battery.

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Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of WO '008 and one of ordinary skill in the art would have found it obvious to configure the size of the container of WO '008 to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

Response to Arguments

18. Applicant's response provides no amendment to claim 16 nor provides any arguments with respect to claim 16 and 18-20. Therefore there is insufficient reasoning or evidence for withdrawing this rejection and the rejection stands.

Claim Rejections - 35 USC § 103

19. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of Nicholson as applied to claim 16 above and in further view of U.S. Design Patent No. D 433,562 (Redlinger).

The teachings of claims 16 with respect to Rosler have been discussed above and are incorporated herein.

The difference between claim 17 and Rosler is that Rosler does not teach of providing a through-hole in the head portion of the lid (claim 17).

Rosler is broadly drawn to a container which can be used as a container for any number of items.

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Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

20. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson applied to claim 16 above and further in view of U.S. Design Patent No. D 433,562 (Redlinger).

The teachings of claims 16 with respect to WO '008 have been discussed above and are incorporated herein.

The difference between claim 17 and WO '008 is that WO '008 does not teach of providing a through-hole in the head portion of the lid (claim 17).

WO '008 is broadly drawn to a container which can be used as a container for any number of items.

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

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The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

21. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of Nicholson as applied to claim 16 above and further of U.S. Design Patent No. D 433,562 (Redlinger).

The teachings of claims 16 with respect to Rosler have been discussed above and are incorporated herein.

The differences between claim 21 and Rosler is that Rosler does not teach of the casing having a cross-sectional shape as a pair of glasses.

The combination of Rosler in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim.

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

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Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement of the batteries in a single battery casing.

22. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson as applied to claim 16 above and further in view of U.S. Design Patent No. D 433,562 (Redlinger).

The teachings of claims 16 with respect to WO '008 have been discussed above and are incorporated herein.

The difference between claim 21 and WO '008 is that WO '008 does not teach of the casing having a cross-sectional shape as a pair of glasses.

The combination of WO '008 in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim.

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses

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since it would have provided a side-by-side arrangement of the batteries in a single battery casing.

Response to Arguments

23. Applicant's response provides no amendment to claim 16 nor provides any arguments with respect to claim 16, 17 or 21. Therefore there is insufficient reasoning or evidence for withdrawing this rejection and the rejection stands.

Claim Rejections - 35 USC § 103

24. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson and Design Patent No. 409,560 (Shim).

WO '008 discloses a case including a main body 2 having a first opening portion at one and a bottom surface 7 at the other end, and a lid portion 1 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 11 run along the length of the main body to the bottom of the body (first and second trains) and another projection train 6 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 8).

Projection portion of trains 11 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 14).

The differences between claims 8 and WO '008 are that WO '008 does not teach of the main body having a cross-section shaped as a pair of glasses (claim 8).

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With respect to storing batteries in the container (claim 8):

WO '008 is broadly drawn to a container which can be used as a container for any object.

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of WO '008 and one of ordinary skill in the art would have found it obvious to configure the size of the container of WO '008 to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

With respect to configuring the case of WO '008 in view of Nicholson to have a cross-sectional shape as a pair of glasses:

The combination of WO '008 in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim (as applied to claim 8).

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses

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since it would have provided a side-by-side arrangement of the batteries in a single battery casing.

25. Claims 9, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of Nicholson and Shim as applied to claim 8 above, and further in view of Redlinger.

The differences not yet discussed are of the head portion and through-hole arrangement defined in claims 9, 13 and 15.

Nicholson discloses that an attachment means provided to at least one of the cover or body of the casing 10 permits attachment of the casing 10 to other devices (see Fig. 1).

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 9, 13 and 15 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by providing a

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through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 by configuring the lid to have the through hole since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

Response to Arguments

26. Applicant's response provides no amendment to claim 8-9 and 12-15 nor provides any arguments with respect to these claims. Therefore there is insufficient reasoning or evidence for withdrawing this rejection and the rejection stands.

Claim Rejections - 35 USC § 103

27. Claims 8, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of Nicholson and Design Patent No. 409,560 (Shim).

Rosler discloses a case including a main body 1 having a first opening portion at one and a bottom surface 1' at the other end, and a lid portion 2 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 3 run along the length of the main body to the bottom of the body (first and second trains) a third projection train 4 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 8).

The bottom surface 1' is expanded toward the outside via a circumferential ring (Figs. 1 and 2 as applied to claim 12).

Projection portion of trains 3 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 14).

The difference between claim 8 and Rosler is that Rosler does not teach of the main body having a cross-section shaped as a pair of glasses (claim 8):

With respect to storing batteries in the container:

Rosler is broadly drawn to a container which can be used as a container for any object.

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of Rosler and one of ordinary skill in the art would have found it obvious to configure the size of the container of Rosler to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

With respect to configuring the case of Rosler in view of Nicholson to have a cross-sectional shape as a pair of glasses:

The combination of Rosler in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim (as applied to claim 8).

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement of the batteries in a single battery casing.

28. Claims 9, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of Nicholson and Shim as applied to claim 8 above, and further in view of Redlinger.

The differences not yet discussed are of the head portion and through-hole arrangement defined in claims 9, 13 and 15.

Nicholson discloses that an attachment means provided to at least one of the cover or body of the casing 10 permits attachment of the casing 10 to other devices (see Fig. 1).

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

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The motivation for providing a through hole in the head portion of the lid is that provides an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 9, 13 and 15 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by configuring the lid to have the through hole since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

Response to Arguments

29. Applicant's response provides no amendment to claim 8-9 and 12-15 nor provides any arguments with respect to these claims. Therefore there is insufficient reasoning or evidence for withdrawing this rejection and the rejection stands.

Claim Rejections - 35 USC § 103

30. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '008 in view of U.S. Patent No. 5,819,917 (Nicholson) and U.S. Design Patent No. D 433,562

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(Redlinger) as applied to claim 1 above and in further view of Design Patent No. 409,560 (Shim).

The difference between claims 24 and WO '008 are that WO '008 does not teach of the casing being capable of storing four batteries when the third projection train engages a second projection train and storing two batteries when the third projection train engages the first projection train.

With respect to storing batteries in the container:

WO '008 is broadly drawn to a container which can be used as a container for any object.

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of WO '008 and one of ordinary skill in the art would have found it obvious to configure the size of the container of WO '008 to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

With respect to configuring the case of WO '008 in view of Nicholson to have a cross-sectional shape as a pair of glasses:

The combination of WO '008 in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim.

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The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of WO '008 in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement of the batteries in a single battery casing. In providing the combined telescoping container with a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement, the container would have been capable of storing either two batteries when the body is full inserted into the cover and capable of storing four batteries when the body is fully extended from but still in mating relationship with the cover via the terminal projection train of each of the body and cover.

31. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of U.S. Patent No. 5,819,917 (Nicholson) and U.S. Design Patent No. D 433,562 (Redlinger) as applied to claim 1 above and in further view of Design Patent No. 409,560 (Shim).

The difference between claim 24 and Rosler are that Rosler does not teach of the casing being capable of storing four batteries when the third projection train engages a second projection train and storing two batteries when the third projection train engages the first projection train.

With respect to storing batteries in the container:

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Rosler is broadly drawn to a container which can be used as a container for any object.

Nicholson discloses providing a cylindrical accessory casing 10 wherein the objects stored in the casing are batteries.

Selection of the particular object for storing is a matter of intended use for the container of Rosler and one of ordinary skill in the art would have found it obvious to configure the size of the container of Rosler to fit any number of cylindrical objects including batteries. The storage of batteries in a cylindrical accessory casing being known in the art as shown by Nicholson.

With respect to configuring the case of Rosler in view of Nicholson to have a cross-sectional shape as a pair of glasses:

The combination of Rosler in view of Nicholson is held to obviate placing batteries in the cylindrical casing.

It is further known in the battery art to place 2 electrical cell in a side-by-side arrangement as show in Fig. 1 of Shim.

The particular shape of the casing is held to be a matter of design choice and further obvious in light of Shim for the purposes of placing two cells in a side-by-side relationship in a single battery casing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler in view of Nicholson by configuring the casing to have a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement of the batteries in a single battery

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casing. In providing the combined telescoping container with a cross-sectional shape as a pair of glasses since it would have provided a side-by-side arrangement, the container would have been capable of storing either two batteries when the body is full inserted into the cover and capable of storing four batteries when the body is fully extended from but still in mating relationship with the cover via the terminal projection train of each of the body and cover.

Response to Arguments

32. Applicant's arguments with respect to new claim 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

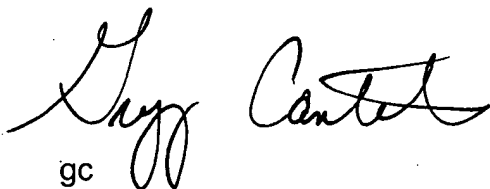
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



gc

Gregg Cantelmo
Primary Examiner
Art Unit 1745

April 20, 2006